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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,131	12/28/2001	Robert A. Dunstan	10559-549001	1605
20985	7590	07/14/2005	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			LEMMMA, SAMSON B	
			ART UNIT	PAPER NUMBER
			2132	
DATE MAILED: 07/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/034,131

Applicant(s)

DUNSTAN ET AL.

Examiner

Samson B. Lemma

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### ***DETAILED ACTION***

1. **Claims 1-30** have been examined.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-30** are rejected under 35 U.S.C. 101 because the subject matter is directed to non-statutory subject matter.

4. **Claims 1-30** are directed to a method of transmitting a decoder core to be used with a predefined content decoder which are both recited as a software in the disclosure. The examiner asserts that the limitation of the claims does not fall within the statutory classes listed in 35 USC 101. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea/software that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

#### ***Claim Rejections - 35 USC § 102***

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-30** are rejected under 35 U.S.C. 102(e) as being anticipated by **Hurtado et al.** (hereinafter referred to as **Hurtado**) (U.S. Patent No. 6,611,812 B2).

63) 7. **As per claim 1, 14, 24, 27 and 29**, **Hurtando** discloses a method comprising: transmitting a decoder core to be used with a predefined content decoder, the decoder core comprising instructions for causing the predefined content decoder to decrypt an encrypted version of digital content. [column 6, lines 10-14] (Once the end user receive permission from the a clearing house after requesting permission, it will be able to access/get the decryption key stored in the container sent/transmitted to the end user/decoder. The end user, by using the decrypting key stored in the container, will decrypt/reproduce/play the previously encrypted content. The method to delivery encrypted digital content to the end user system for the playing/reproducing of the content is also explained on column 5, lines 59-60 and receiving a secure container/storage/medium containing the decrypting key for decrypting the previously encrypted content is also explained on column 5, lines 66-column 6, line 1; column 6, lines 6-10)

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8. **As per claim 2 and 30**, Hurtando discloses a method as applied to claim above.

Furthermore Hurtando discloses the method further comprising receiving a request to access digital content, wherein the transmitting comprises transmitting in response to the request.[column 6, lines 10-14] (End user receive permission from the a clearing house after requesting permission then it will be able to access/get the decryption key stored in the container received or sent/transmitted to the end user/decoder by the clearing house. The end user, by using the decrypting key stored in the container, will decrypt/reproduce/play the previously encrypted content.)

9. **As per claim 3-9: 20-23**, Hurtando discloses a method as applied to claim above.

Furthermore Hurtando discloses the method further comprising receiving a request to access digital content, wherein the transmitting comprises transmitting in response to the request and the decoder core further comprising a decryption key.[column 6, lines 10-14 and column 5, lines 66-column 6, line 14] (The end user is controlled from the reproduction/playing of the content/data in accordance with information stored in the secured container. First the end user gets authentication permission to access the decryption key stored in the secured container to decrypt the content. The clearing house, based on the authentication result, will judge whether or not the end user is authorized to get the permission to access the decryption key stored in the container/storage/medium. If the end user passes the authentication process, it is permitted by the, clearing house to decrypt the content. And the end user will receive a secure container encrypted using the encrypting key of the end user for decrypting the previously encrypted content. The end user using the encrypting key<sup>to</sup> access the decryption key for decrypting the content.)

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10. **As per claim 10-11**, Hurtando discloses a method as applied to claim above.

Furthermore Hurtando discloses the method wherein the content-specific obfuscated software corresponds to a content-specific encryption algorithm, the method further comprising:

**encrypting the requested digital content using the content-specific encryption algorithm; and delivering the encrypted digital content.**[column 5, lines 59-60] **(method to delivery encrypted digital content to the end user system for the playing/reproducing of the content)**

11. **As per claim 12-13 & 25-26**, Hurtando discloses a method as applied to claim above.

Furthermore Hurtando discloses the method wherein the predefined content decoder comprises a previously delivered media player. [column 6, lines 10-14] **(Once the end user receive**

**permission from the a clearing house, it will be able to access the decryption key stored in the container received or sent to the end user. The end user by using the decrypting key stored in the container wil decrypt/reproduce/play the previously encrypted content.)**

12. **As per claim 15-19**, Hurtando discloses a method as applied to claim above.

Furthermore Hurtando discloses the method wherein receiving a decoder core comprises receiving the encrypted digital content and the decoder core together. [column 5, lines 59-

60;column 5, lines 66-column 6, line 1; column 6, lines 6-10] **(As shown on column 5, lines 59-**

**60 the method of delivering encrypted digital content to the end user system for the**

**playing/reproducing of the content is explained . Furthermore receiving a secure**

**container/storage/medium containing the decrypting key for decrypting the previously**

**encrypted content is also disclosed and meets the recitation of the claim.)**

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**/ Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO-Form 892).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**SAMSON LEMMA**

**S.L**

**06/28/2005**

  
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